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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,087	09/25/2000	Carl P Pearson		3364

30621 7590 08/29/2003

JENSEN + PUNTIGAM, P.S.
SUITE 1020
2033 6TH AVE
SEATTLE, WA 98121 -

EXAMINER

HOTALING, JOHN M

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/29/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,087

Applicant(s)

PEARSON, CARL P

Examiner

John M Hotaling II

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The Request for Continued Examination (RCE) filed on 6/18/03 under 37 CFR 1.114 is acceptable and a CPA has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peppel US Patent 6,200,216 in view of Sehr US Patent 6,325,292 and Pearson et al US Patent 5,411,259. The rejection contained in the previous office actions are maintained and incorporated herein. Peppel discloses the use of paper and electronic trading cards for use in digital format where a user of the system can make, trade and use the trading cards over electronic medium including the Internet. Columns 5-8 disclose the cards are used, what types of media the cards are able to used on, that the cards are

media and platform independent, all of the specifics of on-line trading and posting of cards, distribution of cards. Peppel lacks in disclosing a means for verifying that the players have a right to use selected trading cards and the specifics of using a bar code with game specific information thereon. Instead Peppel discloses that the cards are stored and accessed in various media, including on-line media, physical media and paper media (column 5) and that various schemes are employed to ensure scarcity and use of the trading cards such as built in copy protection, authenticity and compatibility with the consumer on line services (columns 12-13). In an analogous invention to Sehr which is a collector card service with a multi-directional communication link to allow the exchange of data/information between and among the system entities including the cardholder via the internet or any other commercial available network technology. Column 1 and in multiple instances throughout Sehr it is discloses that computer programs are utilized to perform house-keeping assignments, computing and decision functions, application-specific routines, and the communications/ networking tasks necessary for the system's operation and **card usage**. These programs further include security means such as cryptographic schemes, digital signatures and authenticity codes, to protect the system, cardholders and card contents against fraudulent use. Pearson discloses that it is well known to use a trading card with readable card information thereon in accordance with a software program in order to play a game. Pearson discloses that the trading card element will have located thereon all of the desired performance data in machine readable form such as bar code, magnetic, optical, or other form. Additionally Pearson discloses that it should be understood that

the invention is not limited to a data format and that the performance data could be stored in memory with the card element having a corresponding access number for the player on the card for the stored data. With respect to claims 1 and 23 please see above. With respect to claims 2-5, 10, 27 where trading cards affecting the characteristics, rules, performance of selected aspects of the system column 6 of Peppel discloses that the cards may be used to operate in the context of a card trading environment and may be combined, for example in an adventure game involving character card that include clues for playing the game. Furthermore columns 10 and 11 state that ETC games are similar in structure to existing video and computer games except for a unique distinction: they require the ETC's to move the action of the game forward and in some cases also generate ETC's in the course of a game.

Disassociated ETC's can serve a number of functions in an adventure game such as: they can offer clues, hints or other special properties that give the owner of the card an advantage when playing the game; augment an existing game with additional levels of play, characters or other game elements; and be offered as a reward or as proof that a player has solved a level of play in the game. With respect to claims 6-9 and 11 see columns 6-8 of Peppel that discloses registering, timing, using copies or replica protection and the trading of cards online. With respect to claims 12, 13 and 19-22 please see the above discussion to Pearson. With respect to claim 16 please see Peppel column 5 line 46. With respect to claims 14, 15, 17, 18, and 24-26 please see column 5 of Peppel and the above discussion relative to Media and Platform independence. Peppel, Sehr, and Pearson are of analogous art in that they are all

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related to the use and security of trading cards for games and entertainment. One of ordinary skill in the art would be motivated to combine the references in that Peppel column 2 that states that his system is for disassociated consumer multimedia, i.e. consumer multimedia products that allow customers to browse, create, collect, and exchange as well as play games (primary activity of the cards, Peppel column 10) with disassociated pieces of multimedia data since the data is media and platform independent (Peppel column 5). It would be obvious to one of ordinary skill in the art to combine Peppel with the security and authentication programs of Sehr and the media structure of Pearson using the motivation provided above.

Response to Arguments

3. In response to the applicants arguments that Peppel is not related to using trading cards to play a game please see 4:43-60 where Peppel clearly discloses that one of the primary purpose for trading cards is for game play and that his system is designed to advocate game play with the trading cards. Peppel discloses that trading cards affect the characteristics, rules, performance of selected aspects of the system, that the cards may be used to operate in the context of a card trading environment and may be combined, for example in an adventure game involving character card that include clues for playing the game. Furthermore, columns 10 and 11 state that ETC games are similar in structure to existing video and computer games except for a unique distinction: they require the ETC's to move the action of the game forward and in some cases also generate ETC's in the course of a game. Peppel discloses that the

registering, timing, using copies or replica protection and the trading of cards online. This is means for detecting the right to use the trading card.

With respect to the applicants arguments relative to storing and downloading of information please see the disclosure of Sehr 2:45-60 provide for a method of compiling the card data elements, which are also stored and maintained throughout a plurality of remote database components, and of issuing the card to a legitimate cardholder, which is entitled to use the card for a predetermined purpose and to provide for a method of protecting data and information stored in, or communicated between and among, the collector card and databases.

With respect to the applicants arguments relative to a single hand held unit please se Sehr 5:50-63. Collector cards can further include PC (Personal Computer) card formats, handheld terminals or any pocket-sized computer configurations. This definition includes cell phones.

With respect to the applicant's arguments relative to a single stand-alone unit, the examiner has combined the references in order to provide the necessary components used in the instant application. The claim limitation specifying that the elements have to be in one unit is understood, however this limitation does little to define patentability of the game. Additionally, the references cited are to a system and the system is combined in a single stand-alone unit. Furthermore, in response to the applicant's arguments that the visual display means, the scanner, and the control system are separate elements please see above with respect to media and platform independence. This means that they can be separate or integral.

In response to the applicant's argument that the patent to Sehr has no teaching concerning a video game system using trading cards please see the rejection above. Sehr does teach in figure 1 and column 5 the use of a collector card in the system and column 20 discloses game play.

In response to the applicant's arguments that none of the reference teaches the use or verification of replica trading cards please see the rejection to Peppel in the previous office action. Additionally, throughout the disclosure of Sehr discloses that the computer programs perform the necessary functions including the communication/networking tasks necessary for the systems operations and card usage 1:35-49, 2:45-52, 4:10-27, 5:35-40 rights, 5:44-47 internet, 7:5-30 use rights, 12:1-7 authentication.

Citation of Pertinent Prior Art

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reber et al '726 discloses a trading card peripheral

Nakamura '162 discloses a trading card game machine

Aberson '400 discloses a trading card system

Sakamoto et al '851 discloses a trading card game

Shuster 383 discloses a trading card system

Muroi '238 discloses a trading card game machine

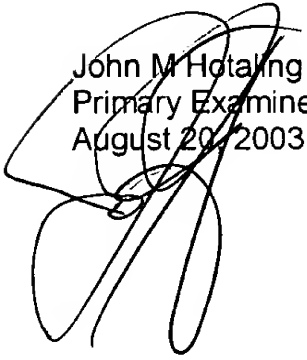
Yamada '651 discloses a trading card game machine

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Hotaling II whose telephone number is 703 305 0780. The examiner can normally be reached on Mon-Thurs 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-4119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7777.



John M Hotaling II
Primary Examiner
August 20, 2003